

## REMARKS/ARGUMENTS

Claims 1-3 and 5-6 were pending in this application. According to the October 25, 2005 Office Action, claims 1-3 and 5-6 were rejected. Applicant has not amended or canceled the pending claims. Accordingly, claims 1-3 and 5-6 are under consideration.

### **Rejection of Claims 1, 3, and 5-6 over Nandram in view of Saffir**

The Examiner rejected previously presented claims 1, 3, and 5-6 as being unpatentable, 35 U.S.C. 103(a), over Nandram et al., U.S. Patent Application Publication No. 2004/0237977 (hereinafter Nandram) in view of Saffir, U.S. Patent 2,804,078 (hereinafter Saffir). Beginning with independent claim 1, it recites a cigarette, comprising:

a rod-shaped tobacco element having a first end and a second end;

a first filter element connected to the first end of the tobacco element;

a second filter element connected to the second end of the tobacco element; and

a tubular wrapper of smokable material enclosing the tobacco element, the wrapper, at a mid-point along the tobacco element between the filter elements has a circumferentially extending first tear line, the tubular wrapper having a second tear line in a region of the first end of the tobacco element so as to facilitate tearing of the wrapper and removal of the first filter element from the tobacco element.

In the Office Action, the Examiner indicated that Nandram teaches through cigarette 10 a cigarette with two filter elements at opposing ends of a tobacco element as recited by claim 1, but that Nandram does not teach first and second tear lines as recited by claim 1. Here, the Examiner indicated that Saffir teaches the use of tear lines and that in view of Saffir, it would be obvious to modify cigarette 10 of Nandram to include first and second tear lines, thereby obviating claim 1. Applicant respectfully disagrees because there is no suggestion or motivation to modify cigarette 10 of Nandram to include a first tear line "at a mid-point along the tobacco element between the filter elements" as recited by claim 1.

Specifically, as shown in Nandram Figure 1, Nandram teaches a cigarette 10 that includes a tobacco element 12 that has a filter element 14 at each opposing end. According to Nandram, cigarette 10 may be used in one of two ways. A user can either break or cut off one of the filter elements 14 to produce a long cigarette or the user can break or cut tobacco element 12 at any position between filter elements 14 to produce two cigarettes. Significantly, Nandram specifically teaches that when the cigarette is used in the latter fashion, tobacco element 12 may be broken at any position between the two filter elements 14 to produce two cigarettes of varying lengths. Accordingly, a specific feature of Nandram cigarette 10 is to allow a user to create two cigarettes of variable/desired lengths. (see Nandram: paragraphs [0007] and [0030]; Independent claims 1 and 5).

Saffir discloses a cigarette that includes a tobacco element 3 having one or more filter elements 9 and 10 at end 4 thereof. A wrapper 5 encases tobacco element 3 and filter elements 9 and 10. As disclosed by Saffir, wrapper 5 includes one or more perforations 6 and 7 in the area of each filter element. These perforations allow a user to remove one or more filter elements from the cigarette, thereby producing a cigarette with varying degrees of filters or no filters.

Applicant respectfully submits that contrary to the Examiner's assertion, there is no suggestion or motivation in view of Saffir to add a first tear line along tobacco element 12 between filter elements 14 of Nandram cigarette 10. Specifically, Saffir only teaches the use of tear lines directed at the removal of filter elements. Saffir does not teach or suggest the use of a tear line along the tobacco element that is directed at breaking the tobacco element into two cigarettes. Accordingly, at most, the obvious combination of Nandram and Saffir is adding a second tear line to tobacco element 12 of Nandram cigarette 10 in a region of one of the two ends so as to facilitate removal of a filter element 14 from tobacco element 12. However, the combination of Nandram and Saffir provides no suggestion or motivation to add a first tear line along tobacco element 12 between filter elements 14.

In addition, even assuming Saffir does suggest adding a first tear line along a tobacco element, there is no suggestion or motivation to add such a tear line along tobacco element 12 between filter elements 14 of Nandram cigarette 10 because such a modification would defeat a specific feature of the Nandram cigarette. In particular, adding such a tear line would only allow a user to break tobacco element 12 at a predetermined point, thereby creating two cigarettes of

predetermined lengths. However, as indicated above, Nandram is specifically directed at allowing a user to create two cigarettes of variable/desired lengths. As such, adding a first tear line along tobacco element 12 between filter elements 14 of Nandram cigarette 10 would be contrary to the teaching of Nandram and as such, there is no suggestion to combine the teachings of Nandram and Saffir.

Furthermore, note that at Nandram paragraph [0030] Nandram specifically teaches that tobacco element 12 “does not need any modification from that of a conventional cigarette ...[in that the tobacco element] is easily breakable.” Accordingly, Nandram specifically teaches away from the need to add first and second tear lines to tobacco element 12.

Accordingly, for the foregoing reasons, applicant submits that Nandram and Saffir do not obviate claim 1, in addition to claims 3 and 5, which depend therefrom.

Turning to independent claim 6, this claim recites limitations similar to claim 1 and is thereby nonobvious in view of Nandram and Saffir for the same reasons as set forth above for claim 1.

#### **Rejection of Claim 2 over Nandram in view of Saffir and in further view of Bauer**

The Examiner rejected previously presented claim 2 as being unpatentable, 35 U.S.C. 103(a), over Nandram in view of Saffir and in further view of Bauer et al., U.S. Patent 2,389,104 (hereinafter Bauer). Claim 2 recites that the tear line of claim 1 “is formed by indentations in the wrapper.” The Examiner indicated that Nandram and Saffir teach the limitations of claim 1 but do not teach the tear line being formed by indentations in the wrapper, as further recited by claim 2. Here, the Examiner indicated that Bauer teaches a serrated cigarette wrapper, that the term serrated is synonymous with indentation, and that in view of Bauer it would be obvious to have created a cigarette, as taught by Nandram and Saffir, to have a tear line formed by indentations in the wrapper.

Because claim 2 depends from claim 1 and Nandram and Saffir fail to teach the limitations of claim 1 as indicated above, claim 2 is nonobvious in view of Nandram, Saffir, and Bauer.

## Conclusion

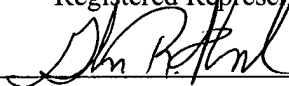
Since Nandram, Saffir, and Bauer fail to teach or suggest applicant's invention as set forth in claims 1-3 and 5-6, applicant submits that these claims are clearly allowable. Favorable reconsideration and allowance of these claims are therefore requested.

Applicant earnestly believes that this application is now in condition to be passed to issue, and such action is also respectfully requested. However, if the Examiner deems it would in any way facilitate the prosecution of this application, the Examiner is invited to telephone applicant's agent at the number below.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on February 27, 2006:

\_\_\_\_\_  
Glen R. Farbanish

Name of applicant, assignee or  
Registered Representative

\_\_\_\_\_  


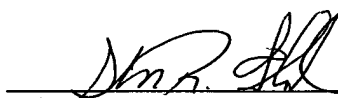
Signature

\_\_\_\_\_  
February 27, 2006

Date of Signature

CPL:GRF/db

Respectfully submitted,

\_\_\_\_\_  


Glen R. Farbanish

Registration No.: 50,561

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212) 382-0700